

REMARKS

Claims 1-22 were pending in the application prior to this amendment. Claims 17-22 have been canceled herein. Claims 1-16 remain in the application unchanged. New claims 23-38 have been added.

New claims 23-38 are fully supported by applicant's originally-filed application with reference, for example, to drawing Fig. 2 and to the written specification, for example, at page 3, lines 11-17. No new matter has been added.

Although this is a preliminary amendment, applicant would like to address the 35 U.S.C. §102(b) rejection of claims 1-16 raised by the Examiner in the Office action mailed March 13, 2003, in the parent application. Accordingly, applicant's comments in this regard are set forth below.

I. Rejection of Claims 1-16 under 35 U.S.C. §102(b)

Claims 1-16 stand rejected (in the parent application) under 35 U.S.C. §102(b) as being anticipated by Sato et al. (U.S. 5,870,654). Reexamination and reconsideration of the Examiner's rejection are requested.

Claims 1-8

Claim 1 recites the following:

A converter for converting a non waste-residue collecting toner cartridge to a waste-residue collecting

toner cartridge, the converter comprising:

- a) a waste-residue collection site; and
- b) a waste-residue remover.

In the preamble of claim 1, a "converter for converting a non waste-residue collecting toner cartridge to a waste-residue collecting toner cartridge" is recited. Sato et al. clearly does not disclose such a converter. Although appearing in the preamble of the claim, this limitation must, nevertheless, be given weight. The MPEP discusses the weight to be given preamble limitations, for example, as follows:

Any terminology in the preamble that limits the structure of the claimed invention must be treated as a claim limitation.

(MPEP 2111.02, citations omitted)

The claim 1 preamble terminology a "converter for converting a non waste-residue collecting toner cartridge to a waste-residue collecting toner cartridge" clearly limits the structure of claim 1 since this terminology establishes that a "converter" is being claimed.

MPEP 2111.02 also states the following:

"[A] claim preamble has the import that the claim as a whole suggests for it." *Bell Communications Research, Inc. v. Vitalink Communications Corp.*, 55 F.3d 615,620, 34 USPQ2d 1816, 1820 (Fed. Cir. 1995). "If the claim preamble, when read in the context of the entire claim, recites limitations of the claim, or, if the claim preamble is 'necessary to give life, meaning, and vitality' to the claim, then the claim preamble should be construed as if in the balance of the claim." *Pitney Bowes, Inc. v. Hewlett-Packard Co.*, 182 F3d 1298, 1305, 51 USPQ2d 1161, 1165-66 (Fed. Cir. 1999). See also *Kropa v. Robie*, 187 F.2d 150, 152, 88 USPQ 478, 481 (CCPA

1951) (a preamble reciting "An abrasive article" was deemed essential to point out the invention defined by claims to an article comprising abrasive grains and a hardened binder and the process of making it. The court stated "it is only by that phrase that it can be known that the subject matter defined by the claims is comprised as an abrasive article. Every union of substances capable *inter alia* of use as abrasive grains and a binder is not an 'abrasive article.'" Therefore, the preamble served to further define the structure of the article produced.)).

The present situation is particularly analogous to that of *Kropa v. Robie* in that it is only by applicant's preamble that the subject matter defined by claim 1 is known to be comprised as a converter. Accordingly, it is improper for the Examiner to completely ignore this limitation. Applicant respectfully requests that, if the Examiner intends to persist in the present rejection, the Examiner explain either why it is believed to be proper to ignore applicant's preamble limitation or why the Examiner believes that Sato et al. discloses a "converter for converting a non waste-residue collecting toner cartridge to a waste-residue collecting toner cartridge".

Claims 2-8 are allowable at least as depending from allowable base claim 1.

Claims 9-13

Claim 9 recites the following:

A converter for converting a non waste-residue collecting toner cartridge to a waste-residue collecting toner cartridge, the converter comprising:

a) means for collecting waste-residue from the photo conductor drum; and

b) means for removing waste-residue from the photo conductor drum and directing the waste-residue into the means for collecting waste-residue.

In a manner similar to claim 1, claim 9 recites, in the preamble, a "converter for converting a non waste-residue collecting toner cartridge to a waste-residue collecting toner cartridge". Accordingly, claim 9 is allowable for at least the reasons advanced above with respect to claim 1.

Claims 10-13 are allowable at least as depending from allowable base claim 9.

Claims 14-16

Claim 14 recites the following:

A method for converting a non waste-residue collecting toner cartridge to a waste-residue collecting toner cartridge comprising the steps of:

- a) positioning a waste-residue collection site within the cartridge proximate a photo conductor drum disposed within the cartridge; and
- b) positioning a waste-residue remover in operable association with the photo conductor drum such that waste-residue is removed from the photo conductor drum upon rotation thereof and deposited into the waste-residue collection site.

In the preamble of claim 14, a "method for converting a non waste-residue collecting toner cartridge

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to a waste-residue collecting toner cartridge" is recited. Sato et al. clearly does not disclose such a method of converting. Although appearing in the preamble of the claim, this limitation must, nevertheless, be given weight. The MPEP discusses the weight to be given preamble statements reciting purpose or intended use, for example, as follows:

During examination, statements in the preamble reciting the purpose or intended use of the claimed invention must be evaluated to determine whether the recited purpose or intended use results in a structural difference (or, in the case of process claims, manipulative difference) between the claimed invention and the prior art. If so, the recitation serves to limit the claim.

(MPEP 2111.02, citations omitted)

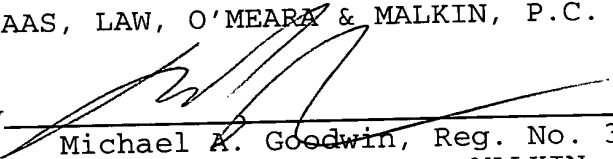
The claim 14 preamble terminology a "method for converting a non waste-residue collecting toner cartridge to a waste-residue collecting toner cartridge" clearly results in a "manipulative difference" since it is only by applicant's preamble that the subject matter defined by claim 14 is known to be comprised as a "method for converting". Accordingly, it is improper for the Examiner to completely ignore this limitation. Applicant respectfully requests that, if the Examiner intends to persist in the present rejection, the Examiner explain either why it is believed to be proper to ignore applicant's preamble limitation or why the Examiner believes that Sato et al. discloses a "method for converting".

Claims 15 and 16 are allowable at least as depending from allowable base claim 14.

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Entry of the amendment presented herein is
respectfully requested.

Respectfully submitted,
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